

REMARKS

This is in response to the Official Action mailed on March 21, 2008. Claims 11-24 are pending in the application. No claims have been amended, added or cancelled herein.

Non-Statutory Double Patenting Rejection

The Examiner has rejected claims 11-24 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,288,588 ("the '588 Patent") and over claims 1-20 of copending Application No. 11/517,623 ("the '623 Application"). In response, Applicants note that the '588 Patent, the '623 Application and the present application are assigned to Eliokem and enclose herewith Terminal Disclaimers to overcome the nonstatutory obviousness-type double patenting rejection. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection under 35 U.S.C. § 103

Claims 11-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burns et al.* (U.S. Patent No. 3,733,289) in view of *Korper* (U.S. Patent No. 5,964,931).

The present invention is directed to a copolymer for use in or as a polymer binder for an intumescent coating comprising a blend of a Newtonian copolymer and a reticulated copolymer, wherein the blend includes at least one substituted styrene and at least one substituted acrylate.

The Examiner contends that *Burns et al.* discloses a method of making an intumescent composition that comprises the vinyl resins of Applicants' invention, and *Korper* discloses a method for producing a coating composition comprising a primary resin, such as Plioway Ultra 200 TM, disclosed by Applicants as being a suitable Newtonian resin, and a secondary resin, such as Plioway Ultra G20 TM, which is disclosed by Applicants as being

a suitable reticulated resin, at page 5 of the specification. Accordingly, the Examiner has concluded that it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to utilize the resins disclosed by either reference to produce the polymer binder for the intumescent coating composition as claimed in the present application. Applicants respectfully traverse because the Examiner has failed to make a *prima facie* case of obviousness since there is no motivation to combine *Burns* with *Korper* to arrive at the claimed invention since *Korper* is non-analogous art.

As stated in the M.P.E.P., "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (M.P.E.P. § 2141.01(a), quoting *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992).)

In the present case, the secondary reference, *Korper's* field of endeavor is a correction fluid marker and a formulation for same. To the contrary, the Applicants' field of endeavor is a polymer binder for intumescent coatings. They are two different fields of endeavors and therefore, in order for *Korper* to be applicable, the art must fall into the second category, namely, "the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved." (M.P.E.P. § 2141.01(a), relying on *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 U.S.P.Q.2d 1481, 1490 (Fed. Cir. 2003).)

In the present case, the particular problem with which the inventor is involved is "to provide a polymer binder for intumescent coating which reduces flame spread during the early stages of a fire and which contributes to improve the char

formation and intumescence during the last stage of the fire." (See page 3, 11.23-27 of the original Specification). However, *Korper* does not pertain to this or any other problem with which the inventor of the present application was concerned. Rather, the inventors of *Korper* were focused on providing a commercially viable correction fluid formulation that dries quickly on a print medium but does not also readily dry on the tip of the nib during repeated use or after a short time without a cap and the correction fluid applicator which would help address the problem. (See col.2 l.54 - col.3 l.5).

As stated in *In re Oetiker*,

The combination of elements from nonanalogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

In re Oetiker, 977 F.2d at 1447.

Rather than finding a proper motivation to combine or otherwise modify the references in the prior art, the rejection is a classic example of hindsight reconstruction in which features are selected from different prior art references in an attempt to create the subject matter claimed in independent claim 11. However, the law is clear. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1993).

Furthermore, the claimed invention is not obvious in view of the primary reference, *Burns*, alone because *Burns* fails to teach the use of (1) a blend of Newtonian copolymer and a reticulated copolymer, and (2) wherein the blend includes at least one substituted styrene and at least one substituted acrylate, as claimed in the present application.

Accordingly, Applicants respectfully request withdrawal of the rejection.

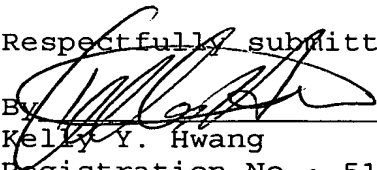
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: August 20, 2008

Respectfully submitted,


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